UNITED STATES DISTRICT COURT

DISTRICT OF NEBRASKA

BOARD OF REGENTS OF THE UNIVERSITY OF NEBRASKA and UNEMED CORPORATION, Plaintiffs, v. SIEMENS HEALTHCARE DIAGNOSTICS INC., Defendant.	No.: 09-CV-03075-RGK-CRZ

REPLY BRIEF IN SUPPORT OF SIEMENS HEALTHCARE DIAGNOSTICS, INC.'S MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-INFRINGEMENT OF U.S. PATENT NO. 5,985,670

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I. INTRODUCTION

Ignoring the patent and common sense, Plaintiffs' Opposition boils down to the argument that the word "different" is somehow interchangeable with the word "same." The reason Plaintiffs urge this illogical position is simple: although the claims of the '670 patent require the use of the same machine readable code on a container and carrier, it is undisputed that Siemens' accused product embeds a different code in the carrier. But Plaintiffs cannot turn their backs on the claims as issued. During prosecution, the applicant deliberately chose to require marking with the "same" codes, and companies such as Siemens were and are entitled to rely on the public record and sell their products with the understanding they would avoid infringement if they used different codes. Plaintiffs cannot "re-draft" the claims now merely to avoid summary judgment. Because a primary purpose of patent claims is to inform the public of the scope of the invention, it would be fundamentally unfair to allow Plaintiffs to draft their claims one way to obtain the patent, only to ignore those very claims in an effort to ensnare Siemens.

Nor can Plaintiffs avoid the conundrum that "different" does not mean "same" by pretending that their construction merely uses the word "correlated." It is undisputed that Plaintiffs intend to apply their construction to cover "correlated" codes that are different, not ones that are the same. Thus, in effect, Plaintiffs ask the Court to re-draft the claim language as follows: "~~same~~ different machine readable code that is correlated." Such a wholesale revision of the claim is legally impermissible and contrary to the plain language of "same," the specification, and the prosecution history.

Once "same" is given its ordinary meaning, summary judgment of no literal infringement is mandated. Summary judgment of non-infringement under the doctrine of equivalents is also appropriate because Plaintiffs are precluded from asserting equivalents for at least three reasons. First, Plaintiffs' theory would vitiate the "same code" limitation and thus violate the "all elements" rule. Second, Plaintiffs' theory is barred by the doctrine of prosecution history estoppel, which precludes patentees from drafting claims narrowly to gain issuance of a patent and then later trying to enlarge the claim scope in litigation to capture an accused product.

Finally, the disclosure-dedication rule precludes application of the doctrine of equivalents. Plaintiffs gave each of these doctrines short shrift in their Opposition, trying instead to churn up purported "disputes of fact" as to whether differences between the claims and the accused products were substantial. However, each of these doctrines independently warrants summary judgment as a matter of law regardless of Plaintiffs' alleged "issues of fact."

Finally, the Markin Declaration fails to raise any *genuine issue* of *material fact*. It is uncontroverted that the accused product does not perform in substantially the same way as the claimed invention. Indeed, the accused product's use of codes that are not the same is, in fact, the *opposite* of the invention's use of the same code on both the container and carrier. The use of different and same codes is not a mere design choice, but fundamental to the operation and functionality of the system.

In short, Siemens does not infringe the '670 patent as a matter of law, and this Court should grant partial summary judgment accordingly.

II. REPLY TO RESPONSE TO STATEMENT OF UNDISPUTED FACTS

In its Opening Brief, Siemens identified the following undisputed facts material to this Motion. In their Opposition, Plaintiffs provided a response to each fact. Below, Siemens sets forth each fact and response together with its reply to each response. Siemens' replies are explained more fully in Section III of this brief.

Parties, venue and jurisdiction:

1. *According to the Complaint, the Plaintiff Board of Regents of the University of Nebraska ("the University") is a public corporate body organized and existing under the Constitution and laws of Nebraska with a principal place of business in Lincoln Nebraska. [Complaint ¶ 1 (Docket No. 1)]. Plaintiff UneMed Corporation is a corporation organized under the laws of Nebraska with a principal place of business in Omaha, Nebraska. UneMed is an affiliate of the University. [Id. ¶ 2].*

Plaintiffs' Response: Undisputed.

2. *Siemens Healthcare Diagnostics, Inc. is a California corporation with its principal place of business in Deerfield, Illinois. [Amended Answer to Complaint and Amended Counterclaims, ¶ 3 (Docket No. 55)].*

Plaintiffs' Response: Undisputed.

3. *This is a patent infringement case arising under Title 35 of the United States Code Section 1, et al, and the parties agree that jurisdiction is appropriate under Title 28 of the United States Code Sections 1331 and 1338(a). [Id. ¶ 5]. The parties also agree that venue is appropriate in this judicial district under Title 28 of the United States Code Sections 1391 and 1400 and that Siemens is subject to personal jurisdiction in this district. [Id. ¶ 6].*

No Literal Infringement:

Plaintiffs' Response: Undisputed.

4. *Each claim of the '670 patent requires the step of marking the "first carrier for transporting the first container with the same machine readable code as said first container." [Hilgard Decl. Exh. A, '670 patent, claims 1-4].*

Plaintiffs' Response: Undisputed that the quoted language accurately recites part of the claim element at issue.

5. *In the accused StreamLAB system, each test tube is marked with a barcode label that is unique at a given point in time and generated specifically for the specimen contained in the test tube. [Id. Exh. D, Plaintiffs' PICs at p. 6; Miller Decl. ¶ 7].*

Plaintiffs' Response: Undisputed for purposes of the present motion.

6. *In the accused StreamLAB system, the puck is embedded with a radio frequency identification (RFID) chip that transmits an identification number that is different than the barcode on any test tube that the puck is holding. [Hilgard Decl. Exh. D, Plaintiffs' PICs at p. 6; Miller Decl. ¶ 6, 8].*

Plaintiffs' Response: For purposes of the present motion, the University does not dispute that the RFID identification number on the StreamLAB carrier (or "puck") is physically different than the bar code identification number. The University does dispute that these numbers are effectively different. The two numbers are associated in a lookup table by a computer in the StreamLAB system. The codes are thus merged and become the same code from the point of view of the system. (Declaration of Dr. Rodney S. Markin, M.D., Ph.D ("Markin Decl.") – Univ. S.J. Ex. 5, ¶¶ 15-16; Miller Decl. – Filing No. 69-8, ¶ 9.)

Siemens' Reply: **Plaintiffs' do not dispute that the RFID identification number on the StreamLAB puck is different than the bar code identification number on the container.** Literal infringement is mandated. Plaintiffs assert that the RFID code on the puck and the barcode on the test tube are "effectively" the same based solely on an inventor declaration, which states:

> The barcode on the specimen container identifies a particular specimen. The look up table, in turn, **cross-references the RFID code on the carrier to the bar code on the specimen**, so that every time a system sensor locates a particular carrier **by sensing its RFID code**, the system **knows the precise location of the associated specimen** (as well as which tests are to be performed on that specimen). [Markin Decl. ¶16].

Plaintiffs' conclusion that the two codes become the "same code from the point of view of the system" is unsupported and immaterial for two reasons. First, Plaintiffs do not (and cannot) assert that "cross-referencing" codes in a "look up table" physically alters the code on the test tube or the code on the puck code to make them the same. Different codes are "cross-referenced," and, in the look up table, the codes remain different.[1] Correlating two things does not make them the same. For example, sharing a line in a look up table does not render two different codes the "same" any more than "cross referencing" a person's street address and telephone number in a telephone book renders the address and phone number the same.

Second, in the claimed invention, the relevant code is the one physically "marked on" the carrier and input into the computer. Indeed, the only way only way to give a carrier a code that is read by a machine (i.e., that is "machine readable," as required by the claims) is to physically put it on (or in) a carrier such that a sensor can read the code. Plaintiffs do not dispute that the code embedded into the StreamLAB puck, which is the code read by the system's RFID sensors, is different than the barcode marked on the test tube.[2] Summary judgment of literal infringement is mandated.

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[1] Markin's statement in his declaration that "every time a system sensor locates a particular carrier by sensing its RFID code" is an admission that the RFID code remains the same, even to the system, throughout the process. [Markin Decl. ¶16.] If the RFID code on the puck magically transformed to become the "same to the laboratory automation system" as the barcode, the system would not need to sense *the RFID code* on the carrier.

[2] Siemens disputes that "marking" the carrier can be performed by embedding a code into a puck, but even if that was considered "marking," it is undisputed that the embedded code in the puck is different than the code on the test tube, and thus summary judgment remains appropriate.

Claim Vitiation and Prosecution History Estoppel Precludes Application of DOE:

7. *Plaintiffs assert the StreamLAB system's "equivalent" of marking the first carrier with the "same machine readable code as said first container" is "associat[ing] the RFID tag on a carrier (puck) with the barcode placed on the specimen container [test tube] . . . ." [Hilgard Decl. Exh. D, Plaintiffs' PICs at p. 6]. In response to the patent Examiner's Rejection over prior art during prosecution of the '670 patent, the patent applicant added new claims to its patent application that for the first time required the carrier to be marked with the "same machine readable code as said first container." [Id. Exh. B, Parent FH at SHD001353-54, (Petition at 13-14), SHD001435, (First Rejection at 4), SHD001445-48, SHD001450, SHD001454 (First Amendment at 1-4, 6, 9)]. The original claims merely required "marking each of the specimen container and carrier with an identification code," which encompassed the alleged equivalent of using different, but associated, codes. [Id. Exh. B, Parent FH at SHD001353-54]. However, the "same machine readable code" claim limitation is narrower and does not allow for different codes. [Id. Exh. B, Parent FH at SHD001445-46, SHD001450, SHD001453 (First Amendment at p. 1-2, 6, 9)]. The applicant was aware (and in fact Plaintiffs claim they have described in the body of the patent application) that different codes could be used and then correlated or associated with each other. [Id.; see also id., Exh. A, '670 patent, at 3:47-49; Exh. B, Parent FH at SHD001347-48, Petition at p. 7-8]. However, in the end, the applicant claimed a narrower invention to secure its patent—i.e., the applicant added the "same … code" language to the claims. [Id. Exh A, '670 patent, claim 1; see Exh. B, Parent FH at SHD001453, First Amendment at p. 9].*

Plaintiffs' Response: Disputed. Specifically, the University asserts that infringement is both literal infringement and infringement under the doctrine of equivalents. As explained below, the University further disputes that the specific language in question – "same machine readable code as said first container" – was the subject of a narrowing amendment made either during the prosecution of the '670 patent or during the prosecution of the '670 patent's parent application. (Univ. S.J. Ex. 3, UNMC/UNEMED002783, UNMC/UNEMED002846.) The University further disputes that the language was added in response to a rejection by the Patent Examiner; in fact, the language in question was never used to distinguish over prior art as claimed by Siemens. The University further disputes that the language constituted a narrowing amendment; in fact, it was included to describe the "directing and tracking" feature in claim 10 as originally presented. (U.S. Patent App. No. 07/997,281 ("Parent Application") – Univ. S.J. Ex. 2, SHD001447- 48, SHD001453-54, SHD001459, SHD001462-63.) The University further disputes that the claim term "same machine readable code" is narrower than "marking each of the specimen container and carrier with an identification code" or that "the same machine readable code" does not allow for different codes on the carrier and container. The University specifically argued during prosecution that the claims were directed to an embodiment where the "carrier 26 is given an identification code which correlates with the specimen container" and the Patent Examiner confirmed that the University "is correct." (Id., SHD001479-80, SHD001490.) Thus, a person of ordinary skill reading the claims, specification and prosecution history would understand that the code on the carrier and the code on the container are correlated, whether the codes themselves are identical or different.

Siemens' Reply: As a threshold issue, Plaintiffs' assertion that "correlating" different codes is the equivalent to using the "same" code establishes that their theory of doctrine of equivalents infringement would vitiate the "same" code limitation. Thus, as set forth in more detail below, the doctrine of claim vitiation precludes Plaintiffs' DOE infringement theory as a matter of law.

With respect to prosecution history estoppel, the parties do not dispute that the entire prosecution history of the '670 patent, including the parent application, has been submitted into evidence. They also do not, and cannot, dispute the literal contents of the prosecution history.

Plaintiffs' efforts to dispute Siemens' description of the prosecution history are unsupported and legally flawed. First, the patentee narrowed his claims by amendment during prosecution for reasons related to patentability. [Hilgard Declaration, Exh. B at 1353-56 (Petition Claims).][3] Plaintiffs do not dispute, and Examiner expressly acknowledged in his Rejection of the original claims, that the code marking and machine-reading steps of the original claims relate to the invention's method of directing and tracking the carrier on the system. [Exh. B at 1445-47 (First Rejection at 4-6); 1353-56 (Petition Claims); 1450-52 (First Amendment at 6-8); Markin Decl. ¶ 12].

All of the original application claims, including the steps related to tracking and directing the carrier, were rejected by the Examiner as obvious in the light of the prior art. [*Id.* at 1445-47 (First Rejection at 4-6).] In response the Rejection over prior art, the applicant filed an Amendment, in which, among other things, he rewrote claim 1 and added new claim 10, which introduced, for the first time, the "same machine readable code" limitation. [Exh. B, at 1450-53 (Amendment).] The applicant explained in his Amendment Remarks that Claim 10 was added to "more specifically call for the method of directing and tracking the movement of the specimen carriers throughout the laboratory." [*Id.* at 1453 (Amendment at 9). Claim 10's code marking limitation was not included in the original marking or code steps, and, as the applicant stated in

3 Hereafter, all evidence cites, unless otherwise noted, are to the Hilgard Declaration attached to the Index of Evidence previously filed.

his remarks, it is "more specific" (i.e., more narrow) than the new limitation because it requires that the code on the carrier be the "same machine readable code . . . as said first container." [*Compare* Exh. B at 1353-56, (Petition at 13-16) with Exh. B at 1447-48 (Amendment at p. 3-4) and Exh. A, claim 1.] In later Amendments, the applicant abandoned all the broader original claims and prosecuted only claims that contained the "same machine readable code" limitation. [*See e.g.*, Exh. C at 2783-85 (Petition at p. 10-12); Exh. A '670, claim 1].

As a matter of law, replacing original broad claims, with an added independent claim that is narrower is a narrowing amendment. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kubushiki Co., Ltd.*, 234 F.3d 558, 587-88 (Fed. Cir. 2000) (en banc), *vacated and remanded*, 535 U.S. 722 (2002), *partially reinstated on remand*, 344 F.3d 1359, 1366-67 (Fed. Cir. 2003) (en banc); *see also Mycogen Plant Sci., Inc. v. Monsanto Co.*, 91 Fed. Appx. 666, 2004 WL 363344, at **2 (Fed. Cir. Feb. 20, 2004); *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 252 F.3d 1306, 1319-20 (Fed. Cir. 2001), *rehr'g denied*, 261 F.3d 1345 (Fed. Cir. 2001), *vacated and remanded*, 535 U.S. 1109 (2002), *reaffirmed on remand*, 91 Fed. Appx. 666, 2004 WL 363344 (Fed. Cir. Feb. 20, 2004); *see also Honeywell Int'l, Inc. v. Hamilton Sundstrand Corp.,* 370 F.3d 1131, 1139 (Fed. Cir. 2004) (en banc).

Second, as set forth in more detail below, Plaintiffs' statement that the "same machine readable code" limitation in question was never expressly used to distinguish over the prior art is misleading and immaterial. The Examiner did not identify any one particular reference as teaching the limitation and instead found all the original (and amended) marking and code limitations obvious based on a combination of prior art references. Because the limitation was obvious in light many prior art patents combined, the applicant had no reason to distinguish the limitation over any particular prior art patent. [Exh. B at 1445-47, 1463, 1461, 1459].

Third, Plaintiffs' statement that the Examiner deemed the applicant's description of the invention "correct" is misleading and immaterial. During prosecution, the applicant appealed the Examiner's rejection, and in his appeal brief, he restated word-for-word (with specific page and line citations) portions of the "Background of Invention" from the original application, including the section on correlating codes, as he was required to do based on formatting rules for appeal briefs. [*See, e.g.*, Supp. Hilgard Decl. Exh. 1, MPEP §1205.02 (Appeal Brief Content); *see* Exh. B, at 1479, 1487 (Appeal Brief and Appendix)]. The Examiner noted that the brief's summary of invention was "correct" because he was likewise required by the rules to confirm "compliance with the content requires of the brief." [Supp. Hilgard Decl. Exh. 2, MPEP § 1205.03 (requiring the examiner and board to "review the brief for compliance with the content requirements of the brief")]. The Examiner did not agree with any substantive disclosures of the brief, and did not opine on the scope of the claims, much less agree with Plaintiffs' proposed construction. The appeal, in fact, was denied.

The Disclosure-Dedication Rule Also Legally Bars Plaintiffs' DOE Theory:

8. *The specification of the '670 patent states: At the specimen receiving station, the carrier is given an identification code which correlates with the specimen container, so that the container and carriage may be directed throughout the laboratory automation system . . . .[Hilgard Decl. Exh. A, '670 patent at 3:47-51]. Thus, a person of ordinary skill in the art reading the patent specification would understand that the first carrier could be given a code that is correlated with the specimen container. [Id.]*

Plaintiffs' Response: Undisputed.

Siemens' Reply: As set forth more fully below in reply to Fact No. 9 and Section III D(3), this Fact is pertinent to establish that the disclosure-dedication rule bars Plaintiffs' theory of infringement under DOE.

9. *Instead of reciting the step of marking the first carrier with a code that is "correlated" with the first container, as disclosed in the patent specification, claim 1 recites marking the first carrier "with the same machine readable code as said first container." [Id. at claim 1].*

Plaintiffs' Response: Disputed. First, the quoted language does not accurately recite the claim limitation. The entire claim limitation reads "marking a first carrier for transporting the first container with the same machine readable code as said first container." ('670 Patent – Univ. S.J. Ex. 1 at 5:45-47.) Second, as explained below, the phrase "same machine readable code as said first container," as applied to the carrier, is properly construed to mean a machine readable code that is correlated with the machine readable code on the first container.

Siemens' Reply: Plaintiffs' first "dispute" is curious. The quoted language in Siemens'

Fact accurately *excerpts* the claim limitation, and Plaintiffs' recitation of the entire claim limitation is likewise accurate. Plaintiff's second "dispute" is based exclusively on a question of law – the proper construction of the "same machine readable code" limitation. As set forth below, this limitation should be given its ordinary meaning, which precludes the use of a different code on the carrier and container.

Importantly, as set forth in more detail below, Plaintiffs do not dispute that the specification discloses to one of ordinary skill in the art that correlated codes – whether the same or different – could be used on the carrier and container. [*See* Undisputed Fact No. 8, above; Opposition at 17, 19-20; Markin Decl. ¶25.] Thus, it is uncontroverted that if the "same machine readable code" limitation is given its ordinary meaning, the disclosure-dedication rule applies as a matter of law to bar Plaintiffs' theory that using correlated codes in the equivalent to using the "same" code for purposes of DOE infringement. This is because whereas Plaintiffs assert that the specification discloses using correlated codes (whether the same or different), the claims do not recite "correlating" codes. The applicant dedicated the use of correlated codes to the public.

Even Without Applying Legal Bars or Claim Vitiation, Plaintiffs' DOE Theory Cannot Prevail:

10. By using different but allegedly "associated" or correlated codes on the test tube and puck, StreamLAB operates in way that is not substantially the same as using the "same code" claimed in the '670 patent because it exploits the differences between two codes, and types of codes, to properly route test tubes and pucks in the automated system. [Miller Decl. ¶10-13].

Plaintiffs' Response: The University does not dispute that StreamLAB uses associated (i.e., correlated) codes on the test tube and puck, and thus the University contends this constitutes at least literal infringement of the '670 patent claims. Under a doctrine of equivalents analysis, the University disputes Siemens' assertions that StreamLAB does not operate in a way that is substantially the same as using the "same code" claimed in the '670 patent and that StreamLAB's use of different codes and types of codes renders it substantially different from the '670 patent claims. Claim 1 of the '670 patent identifies the pertinent characteristic relating to the way in which the codes are marked on both the carrier and the container, namely, that the marked codes are "machine readable." Because the codes are machine readable, patient specimens can be automatically tracked and directed by computer through the laboratory system, without the risks of human error inherent in how lab technicians move and track specimens. For the purpose of this claim element, StreamLAB works in substantially the same way as the '670 patent. (Markin Decl. – Univ. S.J. Ex. 5, ¶¶ 10-15.)

Siemens' Reply: Plaintiffs' "dispute" that the StreamLAB system does not operate in substantially the same way as the claimed invention is conclusory and unsupported. Notably, Plaintiffs' witness does not dispute that by using two different codes, the StreamLAB system exploits the differences between two codes, and types of codes, to properly route test tubes and pucks in the automated system.[4] [*See generally* Markin Decl.]. Further, Plaintiffs assertion that the "pertinent characteristic" of the carrier and container codes is that they are "machine readable" disregards the relevant claim limitation that they also must be the "same." The fact that the carrier code is the "same" in the claimed invention means that a single type of technology must be used on both the carrier and container despite their different roles described in the patent. [Exh. A at 2:18-36; 3:18-34]. StreamLAB's use of two different coding technologies to route specimens is not substantially the same as the claimed method. Using two different codes allows the system to realize the exploit the differences between two different types of codes to conform to the respective – and different – roles of test tubes and pucks, as described in the '670 patent [Miller Decl. ¶13; *see* Exh. A, at 2:18-36; 3:13-34]. This fact is not disputed by Plaintiffs' witness.

11. Using a different RFID code on the puck and then attempting to associate that code with different code on the test tube, such as a barcode, is also a substantially different way of operating because it eliminates the need, under the claimed method, for a technician (or machine) to handle, manage, code and/or re-code a puck each time the puck carries a new test tube and specimen. [Id. ¶ 14].

Plaintiffs' Response: Disputed. The advantages of using machine readable codes on the carrier and the container are explained in the '670 patent:

> Preferably, a computer is incorporated with the laboratory work stations, and includes a sensor located at each work station and archiving station. Each carrier

[4] In fact, Paragraph 19 of the Markin Declaration proves Siemens' point by recognizing that RFID and bar code systems can be different in terms of "relative cost and reliability." [Markin ¶ 19]. He states: "Depending on the needs of a particular system, the implementation of bar code technology could be more or less expensive than implementation of RFID technology." Markin and Plaintiffs do not dispute that StreamLAB systems' use of two different types of codes allows it to exploit the benefits of both. This is fundamentally different than using just one code system as required by the claims.

> and specimen container is marked with an identification code which is read by the sensor and transmitted to the computer. The computer may then operate a carrier removal apparatus at a predetermined work station to remove the carrier at the appropriate location for testing.
>
> * * *
>
> Referring now to FIG. 2, a schematic diagram of specimen movement throughout the laboratory automation system is shown. The specimen arrives at a specimen receiving station 22, where the specimen is entered on a conveyor system designated generally at 24. During the assignment of the task of obtaining a specimen, the laboratory information system would also provide a specimen container marked with an appropriate patient identification code. The inventor has found that a conventional bar code label applied to the specimen container is a simple and efficient method for fulfilling this function. Since most specimen containers are not designed for transport on a conveyor system, a separate carrier 26 is provided to support an individual specimen container on conveyor system 24. At specimen receiving station 22, the carrier 26 is given an identification code which correlates with the specimen container, so that the container and carriage may be directed throughout the laboratory automation system, even when the specimen container is removed from the carriage for specific testing at a work station.
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> Referring now to FIG. 3, an enlarged view of a portion of the schematic of FIG. 2 is shown. Specimen processing station 28 and work station 30 are shown in schematic view to demonstrate each specific work station located along conveyor system 24. As carrier 26 moves along conveyor 24, it will pass within the zone of specimen processing station 28 where a sensor 38 will detect the identification code on carrier 26. In the preferred embodiment of the invention, sensor 38 is a bar code reader while the identification code on the carrier 26 is a bar code. Sensor 38 is connected with the LIS, to record the movement of carrier 26. ('670 Patent – Univ. S.J. Ex. 1 at 2:30-4:23.)

As described in the '670 patent, the carrier and container codes provide a way to (a) include patient identification and desired test information on a particular specimen container, (b) provide a unique identifier on a particular carrier which can be easily correlated with the code on the specimen container, and thereby (c) allow system sensors and computers to direct and track the carrier and, thus, the specimen container, throughout the laboratory system so that tests can be performed on the specimen. (Id.)

The only important aspect of the way in which the carrier codes are marked is so that "sensor 38" can detect the codes, i.e., the codes need to be machine readable to facilitate directing and tracking of the specimens by the automated, computerized system. (Markin Decl.–Univ. S.J. Ex. 5, ¶¶ 12-13.) The precise technology used, whether RFID tags, bar codes, color codes, or other coding technology, is insignificant as long as the codes used on the carriers are "machine readable," and thus can be correlated by the laboratory automation system with the patient identification codes on the respective specimen containers. (Id., ¶ 14.) Further, once the code on the specimen container and code on the carrier are associated in StreamLAB, the two codes are the "same" for the purposes of directing and tracking the specimen container. (Id., ¶¶ 15-16.)

Siemens' Reply: Again, Plaintiffs' alleged "dispute" is based on the flawed premise that the "machine readable" element of the claim limitation is the "only important aspect" of the way in which the claimed method operates in relation to the marking steps. This motion, however, relates to the "same" portion of the "same machine readable code" limitation. Although the excerpt from the '670 patent is accurate, it fails to establish any genuine issue of disputed fact that StreamLAB's use of different codes is a substantially different way of operating than the claimed method's use of the "same" code.

Similarly, Plaintiffs' assertion that the "precise technology used [in the invention] . . . is insignificant" also misses the point. It is not the use of any *specific* code technologies that renders StreamLAB substantially different than the claimed method, it is StreamLAB's use of two *different* codes and code technologies.

Importantly, Plaintiffs do not dispute that under the claimed method (if construed as Siemens proposes), each time a carrier picks up a new container (i.e., at the receiving station) for transport, the carrier must be coded or re-coded so that its code will be the same as the code on the new specimen container. [Exh. A, claim 1, 3:43-53.] In contrast, it is undisputed that using one code on the puck and a different code on the test tube *eliminates* the need, under the claimed method, for a technician (or machine) to code, re-code, handle and/or manage a puck each time it carries a new test tube and specimen, thereby streamlining the directing and tracking process. Plaintiffs' witness concedes that this cannot be achieved where "identical" codes are used and further concedes that these features are "critical" to efficiently process multiple specimens and maximize throughput. [Markin Decl. ¶26]. As such, the StreamLAB system, by using different codes instead of the same codes, operates in a substantially different way than the claimed method.

12. Unlike the claimed method in which a single container must be transported by a single carrier that shares its same code throughout the process, test tubes in the StreamLAB system can be placed in different pucks, with different RFID numbers, during the process. [Id. ¶¶ 15, 16]. This can occur because receiving an RFID number in a puck, unlike reading the "same code" applied to the carrier in the claimed method, does not directly access the identity of the specimen. [Id. ¶ 15; Hilgard Decl. Exh. A, 670 patent, claim 1]. Because the code on the puck is independent from the code on the test tube, the puck can be integrated into the conveyor and re-used without changing its RFID number regardless of the number of test tubes carried. [Miller Decl. ¶¶ 5, 15]. This increases efficiency, maximizes throughput, conserves resources and reduces the possibility of human or machine error (in handling and re-coding the pucks). [Id. ¶15]. The interchangeability of pucks and test tubes – permitted by the use of different codes (and precluded by the use of the "same . . . code") – is fundamentally different from the mono-code approach of the '670 patent, which requires a container and carrier to remain together (or if separated, to re-unite) during the process. [Hilgard Decl., Exh. A, '670 patent, at 3:47-54].

Plaintiffs' Response: Disputed. The claimed method does not require a single container to be transported by a single carrier that shares an identical code with the container throughout the process. ('670 patent–Univ. S.J. Ex. 1 at 5:39-6:19.) Nor does the claimed method require directly accessing the identity of the specimen. As pointed out above, "a sensor 38 will detect the identification code on carrier 26" to facilitate recordation of the movement of the carrier 26. (Id., 4:16-19). Disputed that the code on the puck is independent from the code on the test tube – they are associated in a look-up table. (Miller Decl. – Filing No. 69-8, ¶ 9.) Disputed that the '670 patent requires a "mono-code" approach. ('670 patent – Univ. S.J. Ex. 1, 3:47-53, 5:45-47.) Disputed that the '670 patent requires a container and carrier to remain together or reunite. ('670 patent–Univ. S.J. Ex. 1 at 3:50-53) ("specimen container is removed from the carriage for specific testing at a work station"). The purported "fundamental differences" between StreamLAB and the '670 patent which are described by Mr. Miller are design choices which would occur to a person with ordinary skill in the art. (Markin Decl. – Univ. S.J. Ex. 5, ¶¶ 17-26.)

Siemens' Reply: Plaintiffs' Response fails to create any genuine dispute of material fact for four reasons. First, even if the initial marking step of the claimed invention does not require that the container and carrier stay united or re-unite throughout the process, it is undisputed that if the container is removed from its original carrier, the original carrier, in order to pick up a new container under the claimed method, must be re-coded with the "same" code as on the new container. [*See e.g.*, Markin Decl. ¶ 26.] In contrast, it is undisputed that the StreamLAB's use of two different codes on the carrier and container at the initial step reduces the possibility of human or machine error (in handling and re-coding the pucks) and allows for the puck to be integrated into the conveyor and re-used to carry any number of new test tubes *without* changing its code. [Miller Decl. ¶¶ 5, 15; Markin Decl. ¶ 26.]

Second, Plaintiffs' assertion that the puck code and the test tube code are not "independent" because they are associated in a look up table is unsupported and misses the point. Plaintiffs' own witness expressly concedes that "code independence" maximizes throughput and allows a system to re-use pucks without changing their RFID numbers regardless of the number of test tubes carried. [Markin Decl. ¶ 26]. He further states that "these are the very reasons" why the *specification* of his patent disclose using different correlated codes "rather than requiring that those codes be identical to one another." [*Id.*]. What he does not state, however, is that the claims of the '670 patent require use of the "same" code on the carrier and container.

Third, Plaintiffs' alleged "dispute" that the claimed invention requires a "mono-code" approach is based solely their position that the "same machine readable code" limitation should be construed to cover "different machine readable codes," which, as set forth below, should be rejected in favor of the relevant limitation's common meaning.

Finally, Plaintiffs' assertion that using different codes on the carrier and container is merely a "design choice" is unsupported. Plaintiffs rely on the Markin Declaration, which is largely based on his inaccurate assumption that Siemens is asserting that the StreamLAB does not infringe because it uses a particular *type* of technology on its puck – RFID codes – and a particular *type* of technology on its test tubes – barcodes. [*See* Markin Decl. ¶22-26]. Siemens' position is that, *regardless* of which technologies are employed, the use of one code, and type of code – whatever type is used -- represents a substantially different way of operating than the use of different codes, and different types of codes, on the puck and test tube. The use of different codes fundamentally alters the way in which the system operates and cannot be deemed equivalent to using the claimed method. [Miller Decl. ¶13-15.]

III. LEGAL ANALYSIS

A. The "Same Machine Readable Code" Limitation Should Be Given Its Ordinary Meaning

It is well settled that the claims of a patent define the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*). Moreover, "[a] claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so." *Merck & Co. v. Teva Pharms USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005) (emph. added). Although claims must be construed in light of the specification, a court may not adopt a construction that would either "'broaden [] or narrow claims to give the patentee something different than what he has set forth.'" *Texas Instruments Inc. v. U.S. Intern. Trade Com'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (citation omitted). Finally, claim terms are generally given their ordinary and customary meaning to one of skill in the relevant art at the time of invention. *Phillips,* 415 F.3d at 1312-13.

As set forth in Siemens' Opening Brief, the "same machine readable" code limitation should be given its ordinary meaning, which precludes it from covering the use of "different" codes.[5] The term is not technical, and it has a common meaning that the applicant neither addressed, nor attempted to vary or contradict, in either the specification or prosecution history. *PC Connector Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1362-64 (Fed. Cir. 2005) (where "nothing in the written description . . . amounts to a clear attempt by the patentee to impart any special meaning," terms given ordinary meaning; affirming summary judgment of non-infringement); *Worldwide Innovations & Technologies, Inc. v. Microtek Medical, Inc.*, 2007 WL 2727231 * 2-3 (N.D. Miss. 2007) (granting summary judgment of non-infringement where claim term given ordinary meaning).

Plaintiffs nonetheless urge the Court to construe "same machine readable code" as "machine readable code that is correlated." But Plaintiffs' Opposition fails to own up to their

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5 As Siemens also explained in its Opening Brief, any claim construction issues relating to the "same" limitation may be resolved in the context of this Motion, and do not require a *Markman* hearing.

real proposed construction, which is "a machine readable code that is correlated to another code that is not the same." There is no legal or evidentiary support for this strained and illogical interpretation of the claim. Plaintiffs' attempt to contradict, rather than construe, the claim must be rejected because it is based on: (1) a definition of "similar" rather than the common meaning of the actual claim term "same"; (2) a specification disclosure that does not apply and would impermissibly render the term "same" superfluous; and (3) fundamental mischaracterizations of the prosecution history.

1. The Common Meaning of "Same" Precludes Use of Different Codes

Under the guise of a "common meaning" analysis, Plaintiffs propose to set aside the ordinary meaning of "same" in favor of the word "correlated." Plaintiffs arrive at this definition through a feat of linguistic gymnastics, arguing that "same" means "similar," that "similar" means "corresponding, " that "corresponding" means "correlated" and, since different things may be correlated, "same" must ultimately mean "different." Plaintiffs thus urge a construction that is, in fact, the exact opposite of the actual claim term.

Plaintiffs' self-serving exercise is inherently flawed, among other reasons, because it depends on the definition of a word – "similar" – that does not even appear in the claims. It is the actual words of a claim that define its scope, however, not the words that a patentee wishes were there. *See Phillips*, 415 F.3d at 1312. The operative claim term is "same," and its ordinary meaning is not "similar."

The word "same" is of such common experience that resort to dictionaries is hardly necessary. As the Federal Circuit has explained, "[i]n some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words." *Phillips*, 415 F.3d at 1314. This is precisely such a case. Lawyers, judges, and engineers alike know that "same" is not interchangeable with "similar," much less "correlated" or "different, but correlated."[6]

Indeed, even Plaintiffs' purported sources for defining "same" as "similar" demonstrate that such a construction is improper. For example, Plaintiffs selectively excerpt from a secondary definition in the *American Heritage Dictionary* to allege that "same" means "similar," but ignore the primary dictionary definition (and other definitions) of "same" in that same source.[7] The entire relevant portion of the dictionary definition provides:

> same: "1. **Being the very one**; **identical**. 2. Similar in kind, quantity or degree. 3. **Conforming in every detail**: *according to the same rules as before*. 4. **Being the one previously mentioned or indicated**; aforesaid. [The American Heritage Dictionary (Second College Ed. 1982) (italics in original; bold emphasis added)].

Plaintiffs also conveniently disregard their source's most pertinent description of "same" – i.e., where, as here, two objects are being compared:

> *Synonyms: same, selfsame, identical, equal, equivalent*. These adjectives refer to the absences of difference or disparity. *Same, selfsame* and *identical* are all applicable when only one object is under consideration, in the sense of one and the same: *the same (or selfsame or identical) man I saw this morning*. ***Same* and *identical* are also used when two or more objects are considered. In this sense *same* implies absence of difference between two or more with respect to kind, quality, quantity or the like**; *identical* specifies strict agreement in every respect and detail . . . . [*Id.* (italics in original; bold emphasis added)].

In short, "same" does not mean "similar" or "correlated," but rather means something that conforms in every detail, lacks any differences, or is the one that was previously mentioned, as confirmed by the above definitions and common experience. Thus, the "same . . . code" limitation cannot be infringed by the accused product, because it is undisputed that Siemens' product uses a bar code on the test tube and a different code (and an entirely different *kind* of

[6] Plaintiffs' reliance on *Graver Tank & Mfg. Co. v. Linde Air Prods. Co*., 339 U.S. 605, 608 (1950) is misplaced. The Graver court was merely establishing a framework for analyzing doctrine of equivalents, and it was not construing the term "same" as it appears in claim language.

[7] Plaintiffs' cherry-picked definition from the *Webster's* dictionary is inapplicable because it relates to "same" used as a **pronoun**, whereas the claims use "same" as an **adjective**. [*See* Webster's Third New Int'l Dictionary of the English Language Unabridged (2002) at 2d.] In *Webster's*, the *applicable* definition of "same" as an **adjective** is "resembling in every way: not different in relevant essentials at one time," "being one without addition, change or discontinuance" and "being the one under discussion or already referred to." [*See id.*]. Thus, Plaintiffs' own sources actually support Siemens, not Plaintiffs.

code – an RFID code) within the puck. [Undisputed Fact No. 6.] Plaintiffs cannot ignore the common meaning of "same," and summary judgment of non-infringement is appropriate based on the undisputed facts.

2. The Specification Does Not Support Construing "Same" to Cover "Different" Codes

Plaintiffs also argue that the specification discloses "correlating" the code on the carrier and container to track and direct specimens, and thus according to Plaintiffs, the term "same . . . code" "refer[s] to machine readable codes that are correlated with one another." [Opposition at 16; *see* '670 patent at 3:47-53] This argument fails as a matter of fact and law.

As a factual matter, the specification's disclosure of correlating the codes does not mean (or even imply) that the codes being correlated are the same or different – it simply has no bearing on the issue. Plaintiffs concede as much when they explain that to facilitate directing and tracking specimens, the codes on the carrier and container must be correlated whether or not they are the same or different. [Opposition at 23 ("Using codes that are correlated (whether or not identical) allows the system to operate as described in the `670 patent"); Markin Decl. at ¶ 25 (the invention "relies on correlating the code on the specimen and code on the carrier, whether the codes are identical or different"); ¶ 15 ("The fact that the values of the carrier and container codes may differ is immaterial to the association of these codes").]

Plaintiffs' construction is also legally flawed because it would violate at least two basic canons of claim construction law. First, the construction would impermissibly broaden the scope of the claims (and eviscerate the true meaning of the claim) by reading out the term "same." Instead of requiring the carrier to be marked with the same code, the carrier could be marked with *any* code – same or different – as long as it is correlated. Such a construction would impermissibly render the term "same" "mere surplusage." *See, e.g.*, *Texas Instruments Inc. v. U.S. Intern. Trade Com'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (rejecting patentee's proposed claim interpretation where it "would read an express limitation out of the claims" and render a claim term "mere surplusage"); *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1119 (Fed. Cir. 2004) (rejecting construction that "largely reads the term 'operatively' out of the phrase 'operatively connected'" and would render the term superfluous); *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003) (reversing construction where district court improperly read out the limitations contained in the claim language). The patentee deliberately chose to limit its claims to marking a carrier with the same machine readable code as the container, and that term cannot be read out of the claim. *Texas Instruments*, 988 F.2d at 1171.

Second, this is not a situation, as Plaintiffs imply, where the patentee acted as his own lexicographer by defining "same" to mean "different" or "different but correlated." Although an applicant may act as a lexicographer in the specification, "the specification cannot support a definition that is contrary to the ordinary meaning of a claim term unless it communicates a deliberate and clear preference for this alternative definition." *Kumar v. Ovonic Battery Co., Inc.*, 351 F.3d 1364, 1368 (Fed. Cir. 2003). Here, the inventor never provided *any* definition of the term "same code" in the specification, much less a "deliberate and clear preference" for a a "same code" to mean "any code" or "different code" that is "correlated." In short, the inventor did not act as his own lexicographer, and the term cannot be given any construction other than its ordinary meaning.

3. Plaintiffs Misconstrue The Prosecution History, Which Supports A Common Meaning Approach

Plaintiffs also resort to mischaracterizing the prosecution history in two ways to fabricate support for their illogical position that "same" can mean "different." First, Plaintiffs assert that the Patent Office somehow understood that "same" could mean "different but correlated" based on a brief filed by the patentee during the appeal of the rejection of the parent application for the '670 patent. This argument is based on selective citations to the applicant's appeal brief, which included the "correlation of codes" disclosure in its "background of invention" section of the appeal brief. But the applicant's brief merely set forth word-for-word excerpts of the same "Summary of Invention" part of the specification included in the original application, and the applicant only repeated those portions because it was required to do so under applicable appeal brief formatting rules. [*See, e.g.*, Supp. Hilgard Decl., Exh. 1, MPEP §1205.02 (v) (Appeal Brief Content must include "A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters")*; see* Exh. B, at 1479, 1487 (Appeal Brief and Appendix).] Plaintiffs' characterization of this brief as showing that the patentee "expressly described" its alleged invention as using correlated codes is misleading.

Plaintiffs' assertion that the Examiner "agreed" with the patentee's (alleged) characterization of the invention is likewise misleading. Rather, the Examiner merely noted that the brief's summary of invention was "correct" in that it conformed to the formatting rules. [Supp. Hilgard Decl. Exh. 2, MPEP § 1205.03 (requiring the Examiner and board to "review the brief for compliance with the content requirements of the brief").] The Examiner never "agreed" with the substance of the patentee's statements or the scope of any particular claim limitations.

Second, Plaintiffs incorrectly argue that the Examiner "implicitly found" that the "same machine readable code" element was taught by prior art that did not describe "identical" codes. [Opposition at 18.] According to Plaintiffs, because the prior art Uchida Patent discloses the use of different kinds of codes, and because the Examiner rejected the claim under the Uchida Patent, the Examiner must have concluded that the Uchida Patent "taught" the use of the "same machine readable code" through its disclosure of different codes. Plaintiffs thus suggest the Examiner must have believed that "same" does not require an "identical" code. But this attenuated reasoning has no evidentiary support. The Examiner never found that Uchida alone disclosed the "same machine readable code" element. Instead, the Examiner found that rejected claim 10 was obvious based on several patents, including the Okuno Patent (which discloses applying bar codes to carriers), the Wakatake Patent (which discloses using identification numbers), the Uchida Patent, and four other prior art patents. [*See* Exh. B, at 1461, 1463

(Second Rejection).][8]

Indeed, the Examiner's discussion of Uchida did not even expressly involve the "same machine readable code" limitation. The Examiner found only that Uchida teaches "labeling both the specimen container and carrier" [Exh. B, at 1459], not that it teaches the "same machine readable code" limitation. Thus, the Examiner relied on multiple references to reject the applicant's claims as unpatentable and did not consider that the "same machine readable code" limitation was specifically taught by the Uchida Patent (or any other patent).[9] [Exh. B, at 1463 (Second Rejection); *see also id.* at 1461 & 1459.]

In short, Plaintiffs' implausible construction lacks any legitimate support, and "same code" should be given its ordinary meaning, which mandates entry of partial summary judgment of non-infringement.

B. Plaintiffs' Infringement Theories Would Violate The Public Notice Function Of Patents

As a threshold matter, Plaintiffs' infringement theories (both literal and under the doctrine of equivalents) contravene the public notice function served by patents. Because a patent's claims delineate the patentee's right to exclude, the patent statute mandates that a patent's claims must inform the public of the bounds of the allegedly protected invention – i.e., what subject matter is covered by the exclusive rights of the patent. *Halliburton Energy Services, Inc. v. M-I LLC*, 514 F.3d 1244, 1249 (Fed. Cir. 2008). As the Supreme Court has recognized for over one hundred years, the purpose of this requirement "is not only to secure to [the patentee] all to which he is entitled, but to apprise the public of what is still open to them." *McClain v. Ortmayer*, 141 U.S. 419, 424 (1891). Otherwise, competitors cannot avoid

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8 Likewise, the Examiner rejected the original application claims, including the broad marking steps, as "obvious" in light of Okuno, Wakatake and Uchida. [*Id.* at 1435.]

9 As a result, Plaintiffs' assertion that the applicant never attempted to distinguish Uchida "on the basis that the Uchida Patent did not teach identical codes" is unpersuasive. Because the Examiner found the claims obvious in light of *multiple* references, the applicant had no reason to argue that any single patent failed to disclose the "same code" limitation.

infringement, defeating the public notice function of patent claims. *Halliburton*, 514 F.3d at 1249, *citing Athletic Alternatives, Inc. v. Prince Mfg., Inc.,* 73 F.3d 1573, 1581 (Fed. Cir. 1996).

Here, the patentee informed the public through the claims of the '670 patent that he was claiming an invention that required the "same" machine readable code on carrier as on a container. The public at large, including competitors such as Siemens, was entitled to rely on the plain scope of those claims to avoid infringement. Plaintiffs cannot now claim a different scope that is effectively the *opposite* of what the public was told (i.e., that the invention instead covers situations where the carrier uses a different code). To allow Plaintiffs to do so would violate the public notice function of patents. *See id.* This fatal flaw infects Plaintiffs' entire infringement case, both literal and under the doctrine of equivalents.

C. Partial Summary Judgment of No Literal Infringement Is Appropriate

Summary judgment of no literal infringement is appropriate for one simple reason: it is undisputed that Siemens' StreamLAB product uses a puck (carrier) RFID code that is different – and thus not the "same" as – the test tube (container) barcode. [Undisputed Fact No. 6.]

Plaintiffs try to manufacture a dispute of material fact to support literal infringement through a declaration in which the inventor, Dr. Markin, states that the *different* puck code and test tube code effectively become the *same* "to the laboratory automation system," because they are "cross referenced" in a "look up table" and thereby refer to the "same specimen."[10] [Markin Decl. ¶16; Opposition at p. 6, 20.] Plaintiffs' argument fails for at least three reasons.

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10 Dr. Markin's litigation-driven assertion is particularly disingenuous given that he was well aware of how generally to claim "associating" the same or different codes, versus how to claim using the "same" code. During prosecution of the '670 patent, Dr. Markin filed an application which issued as U.S. Patent No. 5,589,137 ("the '137 patent"). [Hilgard Decl. Exh. F.] The '137 patent claims a carrier that includes a label "having identification indicia thereon relating to a specimen *associated* with the carrier." [*Id*. at claims 8, 9 (emphasis added).] In contrast, in the '670 patent, Dr. Markin specifically required more than a mere "association" or correlation – he required that the carrier be marked with the "same machine readable code as used on the first said container." [*Id.* Exh. A, claim 1.] In short, Dr. Markin's statements at the time of patenting – which show he knew the difference between claiming "associating" and using the "same" code – are the best indication of his true views on the matter, not his litigation-driven declaration. As set forth in Siemens' separately-filed Objections to Evidence, the Markin Declaration is objectionable on numerous other grounds as well.

First, as a threshold matter, the Federal Circuit has made clear that inventor testimony generally does *not* carry weight for claim construction. *Howmedica Osteonics Corp. v. Wright Med. Tech., Inc.*, 540 F.3d 1337, 1347 (Fed. Cir. 2008). Thus, an inventor's testimony cannot be relied on to change the meaning of claims. *Id.., citing Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 983 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). As the Federal Circuit has explained, "it is not unusual for there to be a significant difference between what an inventor thinks his patented invention is and what the ultimate scope of the claims is after allowance by the PTO." *Id.*

Second, it is indisputable that the test tube barcode and the puck RFID code are always different regardless of any cross-referencing. Plaintiffs allege the codes "are merged and are the same to the laboratory automation system" because the system "cross-references" the codes in a "look up table" to identify and locate the specimen. But it is uncontroverted that the test tube barcode and puck RFID code remain different throughout operation of the accused system. Plaintiffs do not (and cannot) assert that "cross-referencing" codes in a "look up table" physically alters the test tube code or puck code to make them the same.[11] [*See* Markin Decl. ¶16.] Indeed, any two different data items can be correlated, and that does not make them the same. For example, merely sharing a line in a look up table does not render two different codes the "same" any more than "cross referencing" a person's street address and telephone number renders the address and phone number the same.

Finally and importantly, the "same machine readable code" must be "marked on" the carrier. [Exh. A, claim 1.] Indeed, the only way for the machine (sensor) to "read" a code on a carrier is to have the code physically placed on the container. Moreover, the claims require "inputting information into a computer database . . . including . . . the code marked on the container and carrier . . . ." [*Id.*] It is indisputable that when the StreamLAB puck is given its machine readable code, that code is different than any barcode on a test tube that will be carried by the puck.[12] Any alleged "correlation" or "cross-referencing" in a look up table occurs afterward, and in any event never actually changes the puck's RFID code.[13] Thus, because different codes are "marked," there is no infringement even if those codes are later associated.

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[11] Indeed, if the RFID code on the puck became the "same to the laboratory automation system" (i.e., actually became the same barcode label on the test tube), the system would not need to use an RFID sensor to read the *RFID code* repeatedly throughout the process, as Plaintiffs concede occurs. [*Id.*]

Summary judgment of no literal infringement is mandated because the StreamLAB system puck RFID code is a different code, and a different kind of code, than the bar code on the test tube.

D. Partial Summary Judgment of No Infringement Under the Doctrine Of Equivalents is Appropriate

Realizing it has no viable shot at literal infringement, Plaintiffs' Opposition focuses on the doctrine of equivalents ("DOE"). Plaintiffs assert that correlating different codes is equivalent to marking the carrier with the same code as the specimen container. But because Plaintiffs' DOE theory would operate to vitiate a claim limitation, it is barred as a matter of law. Plaintiffs' DOE theory is also foreclosed by (1) the doctrine of prosecution history estoppel and (2) the disclosure-dedication rule. Finally, Plaintiffs fail to point to a single *material* fact that would prevent entry of summary judgment based on the traditional DOE infringement tests. As discussed below, each of these flaws is fatal to Plaintiffs' DOE theory, and summary judgment of non-infringement is thus also appropriate under the doctrine of equivalents.

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12 Siemens disputes that "marking" the carrier can be performed by embedding a code into a puck, but even if that was considered "marking," it is undisputed that the embedded code in the puck is different than the code on the test tube, and thus summary judgment remains appropriate.

13 And even under Plaintiffs' construction of "marking" as "providing" (which should be rejected, as set forth in Siemens Opening Markman Brief), there is no infringement because it is uncontroverted that the RFID code "provided" to the StreamLAB puck that is "input[] into a computer database" is different than the barcode "provided" to the test tube, and they remain different even if they share a line a look up table in the computer. [*See id.* claim 1; Joint Claim Construction Statement, Docket No. 64, at 2 (Plaintiffs' proposed construction of "marking" as "providing").]

1. DOE Is Precluded Because the Alleged Equivalent Would Vitiate the "Same . . . Code" Limitation

Plaintiffs' Opposition confirms that they seek to capture through the doctrine of equivalents the StreamLAB system even though doing so would vitiate the "same . . . code" limitation. As set forth in Siemens' moving papers, the "all elements" rule prevents the application of the doctrine of equivalents where, as here, a finding of equivalents would vitiate a claim limitation. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.,* 520 U.S. 17, 39 n. 8 (1997). Claim vitiation applies when there is a "clear, substantial difference or a difference in kind" between the claim limitation and the accused product. *Trading Technologies Intern., Inc. v. eSpeed, Inc.*, 595 F.3d 1340, 1356 (Fed. Cir. 2010)**,** *citing Freedman Seating Co. v. Am. Seating Co*., 420 F.3d 1350, 1360 (Fed. Cir. 2005). It does not apply when there is a "subtle difference in degree." *Id.*

Plaintiffs try to avoid this rule by arguing that it would not vitiate an *entire* claim limitation if "same machine readable code" encompassed different codes that were correlated. Plaintiffs incorrectly suggest they are allowed to vitiate the word "same" because it is only a single word in the claim and that "one-to-one literal correspondence with every word in the claim" is not required. Plaintiffs miss the point entirely.

Contrary to Plaintiffs' suggestion, the "all elements" rule may absolutely be applied where a single word is at issue. The point is whether there is a "substantial difference" versus a "subtle difference in degree" between the claim limitation and the accused product. Where, as here, the application of the doctrine of equivalents would eviscerate a key claim term (whether one word or many) and thus vitiate an entire limitation, the "all elements" rule precludes its application.[14] *See, e.g.*, *Trading Technologies*, 595 F.3d at 1356 ("all elements" rule precluded

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[14] The cases cited by Plaintiffs are distinguishable because they did not involve differences that were inherently substantial and thus would have vitiated any claim limitations. *See, e.g.*, *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 850 (Fed. Cir. 2006) (theory that "dome" equivalent to "plate" did not effectively limit "plate" limitation in its entirety, where court had construed "plate" to require a structure "of relatively uniform thickness and flatness which may also have some moderate curvature to it"); *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*,
Continued on following page

equivalents where software's automatic re-centering feature would render meaningless the claim limitation "static" – synonymous with only manual re-centering); *Asyst Techs., Inc. v. Emtrak, Inc.,* 402 F.3d 1188, 1195 (Fed. Cir. 2005) (affirming application of "all elements" rule where finding "unmounted" equivalent to "mounted on" would vitiate the limitation); *SciMed Life Sys. v. Advanced Cardiovacsular Sys.,* 242 F.3d 1337, 1347 (Fed. Cir. 2001) (explaining that "if a patent states that the claimed device must be 'non-metallic,' the patentee cannot assert the patent against a metallic device on the ground that a metallic device is equivalent to a non-metallic device.").

Here, Plaintiffs' equivalency theory posits infringement based on a different (albeit correlated) code and would thereby vitiate the limitation requiring marking of the "same machine readable code." This is not a "subtle difference in degree" – it is a fundamental difference in kind. *Trading Technologies*, 595 F.3d at 1356.

Moreover, this is not a situation where the patentee could not have foreseen the limiting impact of using the term "same" at the time of drafting. As the Federal Circuit emphasized in a similar context:

> The claim at issue defines a relatively simple structural device. A skilled patent drafter would foresee the limiting potential of the "over said slot" limitation. No subtlety of language or complexity of the technology, nor any subsequent change in the state of the art, such as later-developed technology, obfuscated the significance of this limitation at the time of its incorporation into the claim. If [the patentee] desired broad patent protection for any container that performed a function similar to its claimed container, it could have sought claims with fewer structural encumbrances.... Instead, [the patentee] left the PTO with manifestly limited claims that it now seeks to expand through the doctrine of equivalents. However, **as between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure**.

Freedman, 420 F.3d at 1360-61, *citing Sage Prods., Inc. v. Devon Indus., Inc.,* 126 F.3d 1420,

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469 F.3d 1005, 1019 (Fed. Cir. 2006) (question of fact existed as to whether difference between "spherically-shaped" limitation and defendant's "cylindrical-conical shape" was substantial).

1425 (Fed. Cir. 1997) (citation and footnote omitted). Put simply, the applicant could have sought language that did not require the "same" machine readable code but did not – and Plaintiffs cannot now vitiate that limitation by seeking to capture it through the doctrine of equivalents.

Finally, Plaintiffs' violation of the "all elements" rule is not somehow salvaged by the notion that the Court would still need to find, under Plaintiffs' theory, that machine readable codes for the container and carrier are "correlated." Again, Plaintiffs simply miss the point. A finding of equivalency under Plaintiffs' theory would require that "same" code instead means "different, correlated code." Because such a finding would vitiate the claim limitation, the "all elements" rule prohibits the application of the doctrine of equivalents as a matter of law regardless of the fact that Plaintiffs seek to add a "new" element ("correlated") to the claim. The Court should grant summary judgment accordingly.

2. The Doctrine Of Prosecution History Estoppel Bars Plaintiffs' DOE Theory

Plaintiffs' attempt to avoid prosecution history estoppel hinges on their position that there was no narrowing amendment that would trigger the doctrine, and that even if there was, the presumption of surrender is rebutted. Their position is false as a matter of fact and law.

As Plaintiffs acknowledge, prosecution history estoppel prevents application of the doctrine of equivalents where, as here: (1) there was a narrowing amendment during prosecution that surrendered subject matter; (2) the narrowing amendment was made for reasons of patentability; and (3) the alleged equivalent falls within the scope of the surrendered subject matter, taking into account the presumption of total surrender for the limitation. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.,* 535 U.S. 722, 736 (2002) (hereinafter "*Festo VIII*"). Where the prosecution history is silent on the rationale for the narrowing amendment, it is presumed to be made for reasons of patentability. *Id.*

To overcome the presumption, the patentee must show that at the time of amendment, "one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent." *Id.* at 741. To do so, Plaintiffs would need to show that (1) "[t]he equivalent [was] unforeseeable at the time of the application," (2) "the rationale underlying the amendment [bears] no more than a tangential relation to the equivalent in question, or (3) "there [was] some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question." *Id.* at 740-41.

Here, Plaintiffs attempt to defeat prosecution history estoppel by asserting that (1) the addition of the "same machine readable code" limitation does not constitute a *narrowing amendment* during prosecution; (2) the "machine readable code" limitation was not made for reasons of patentability; and (3) the presumption that prosecution history estoppel applies is rebutted because the "rationale underlying the amendment [bears] no more than a tangential relationship to the equivalent in question." Plaintiffs are wrong on each point.

First, Plaintiffs' position that there was no amendment at all is disingenuous at best. The patentee added claim 10 (including the "same . . . code" limitation) as part of an Amendment of the original claims in the parent application, in response to an Examiner's rejection of claims that were later abandoned.[15] [Exh. B at 1450, 1453.] Plaintiffs contend that because claim 10 was added as a new claim in favor of claims that were later abandoned, there was technically no "amendment."[16] This argument ignores the law and the facts.

Indeed, the Federal Circuit has squarely rejected Plaintiffs' position. Specifically, the Federal Circuit has held that the doctrine of prosecution history estoppel applies with equal force where the added claim element was introduced through a new independent claim, instead of through an amendment to an original claim. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kubushiki Co., Ltd.*, 234 F.3d 558, 587-88 (Fed. Cir. 2000) (en banc), *vacated and remanded on other grounds*, 535 U.S. 722 (2002), *partially reinstated on remand*, 344 F.3d 1359, 1366-67 (Fed. Cir.

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15 Claim 10 in the parent application ultimately issued, in amended form, as claim 1 of the '670 patent.

16 Plaintiffs also contend there was no "amendment" because claim 1 itself was never significantly amended after being added. Of course, this misses the point, as claim 10 itself amounts to an amendment of the original claims. As such, Plaintiffs' comparison chart of claim 10 with the issued claims is a red herring. [*See* Opposition at 29-30.]

2003) (en banc); *see also Mycogen Plant Sci., Inc. v. Monsanto Co.*, 252 F.3d 1306, 1319-20 (Fed. Cir. 2001) ("We do not discern any legally significant difference between canceling a claim having a broad limitation and replacing it with a claim having a narrower limitation, and amending a claim to narrow a limitation. To do so would place form over substance . . . ."), *rehr'g denied*, 261 F.3d 1345 (Fed. Cir. 2001), *vacated and remanded*, 535 U.S. 1109 (2002), *reaffirmed on remand*, 91 Fed. Appx. 666, 2004 WL 363344 (Fed. Cir. Feb. 20, 2004); *see also Honeywell Int'l, Inc. v. Hamilton Sundstrand Corp.,* 370 F.3d 1131, 1139 (Fed. Cir. 2004) (en banc) (proper focus is whether "scope of the claims has been narrowed by amendment during prosecution."); *see also Mycogen Plant Sci., Inc. v. Monsanto Co.*, 91 Fed. Appx. 666, 2004 WL 363344, at **2 (Fed. Cir. Feb. 20, 2004) ("Among the rules from the original *Festo* en banc decision that were unchanged by the Supreme Court and reaffirmed by this court in *Festo IX* was our holding that cancellation of claims for reasons related to patentability in favor of claims with a narrower literal scope has the same presumptive effect on claim limitations as amending the claims directly.").

In this case, the original application claims did not include any marking or code steps that required use of the "same machine readable code" on the carrier and container. [Exh. B, at SHD 1354 (Application) (dependent claim 2 merely required marking with an "identification code," claim 4 included providing a sensor for "reading said identification code on said carrier" as it moves on the conveyor, and claim 5 included transmitting the code to the computer as the carrier moves on the system).] After all the original claims were rejected as obvious, the applicant, in his first Amendment, revised application claim 1 and added a new independent claim 10, which introduced for the first time the more narrow "same machine readable code" language. [*Id.* at 1435-37 (Rejection); 1450-53 (Amendment).] Importantly, in subsequent Amendments, the applicant abandoned all the original and amended claims and prosecuted in their place only independent claim 10, with the "same machine readable code" language, and claims dependent thereon.[17] [Exh. C, at 2783-85; *see* Exh. A, claims 1-4.] Thus, as a matter of law and fact, the "same machine readable code" limitation was added by amendment to overcome the prior art. *See Festo,* 234 F.3d at 587-88; *see also Mycogen*, 252 F.3d at 1319-20; *Honeywell,* 370 F.3d at 1139.

Similarly, there is no question that adding the "same machine readable code" element to the patent claims *narrowed* their scope. A simple comparison of the marking step of original claim 2 (later incorporated into original claim 1, and eventually abandoned) and claim 10 shows that claim 10 is more narrow because it has more requirements, i.e., that the carrier code must be both the "same" and "machine readable."

Original claim 2 and amended claim 1 (abandoned in favor of prosecuting claim 10 and claims dependent thereon)	**Claim 10** (added by amendment filed in response to the Examiner's First Rejection)
"The method of claim 1, further comprising the step of marking **each of the specimen container and carrier** with **an identification code**, prior to the step of placing the carrier on the conveyor"	"marking the first container with a **machine readable code**; marking a first carrier for transporting the first container with **the same machine readable code as said first container**, and placing the container thereon"

Moreover, the applicant conceded he added claim 10, which includes the "same machine readable code" limitation, to "*more specifically* call for the method of directing and tracking the movement of the specimen carriers throughout the laboratory." [*Id*. Exh. B, Parent FH at SHD001453, First Amendment at 9 (emphasis added)]. This admission confirms the obvious: because claim 10's limitations are more "more specific," they are narrower than the original application claims.

Second, Plaintiffs are wrong that the amendment adding claim 10 was not related to

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17 Plaintiffs erroneously assert that the "critical language of [application] claim 2 . . . was not abandoned, but was moved to claim 1 of the parent application." [Opposition at 31, n. 4 (emphasis added).] What Plaintiffs fail to tell the Court, however, is that claim 1 of the parent application itself was abandoned – along with the broad marking step of application claim 2 – during prosecution. Indeed, none of the issued claims contain the broad, "critical language" recited by Plaintiffs, which was thus obviously abandoned in favor of the more narrow "same machine readable code."

patentability. Plaintiffs argue that the Examiner's rejection of the original claims did not relate to the "directing and tracking" features of the invention, and thus the applicant's stated reason for adding claim 10 was merely to "point out a feature of the invention, namely, 'directing and tracking' of the specimen carriers." [Opposition at 32.] The Examiner, however, expressly found that the marking and identification code limitations in the original application claims did relate to "directing and tracking" of specimen carriers, and that they were obvious based on prior art.[18] Thus, for any patent to issue, the applicant was required to narrow the limitations relating to "directing and tracking" (including the marking and code elements). And this is precisely what the applicant did with claim 10, which he conceded was intended to "more specifically call for the method of directing and tracking the movement of the specimen carriers throughout the laboratory." [Exh. B, at 1453 (First Amendment) (emph. added).]

Specifically, claim 10's marking steps include (narrowed) elements from at least (rejected) claims 2 and 4. For example, (rejected) claim 4's recitation that "identification codes" can be automatically sensed to locate the carrier is captured in the added "machine readable" requirement of claim 10. [*See, e.g.,* Markin Decl. ¶ 12 ("Because the codes are machine readable, patient specimens can be automatically tracked and directed."); ¶ 13 (codes "allow system sensors and computers to direct and track the carrier . . .").] Application claim 2's recitation that both carrier and container are marked is also captured in the two marking steps of claim 10. Importantly, claim 10's marking steps are also much more narrow than application

18 Specifically, the Examiner rejected as obvious application claim 2, which required marking with an "identification code," noting that identifying the specimen with a code permits the system to "prioritize the order of processing" (which relates to directing the specimen). [Exh. B, at 1435.] Likewise, he rejected as obvious application claims 4 and 5, which required automatic "sensing" and "reading" of the carrier "identification code" and transmitting the code to the computer, noting that "sensing of the position of the carrier by code, logging of data by code and control of movement by code permits positive identification of the location of a carrier" (which relates to directing and tracking the specimen). [*Id.* at 1437 (emph. added).] Plaintiffs also concede that marking, sensing and transmitting the code is crucial to directing and tracking the specimen, and thus they cannot legitimately argue that the Examiner's rejections over prior art of the original claims was unrelated to directing and tracking, or that claim 10 was merely intended to introduce these features for the first time into the scope of the claims. [*See* Markin Decl. ¶¶ 12, 13.]

claims 2 and 4 because, among other things, the codes must be the "same" and "machine readable." [*Id.*, claim 10.] Thus, the applicant "more specifically call[ed] for the method of directing and tracking" the specimen carriers, and narrowed claim 10 was added for patentability reasons, giving rise to prosecution history estoppel. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.,* 344 F.3d 1359, 1366-67 (Fed. Cir. 2003), *citing Festo VII,* 535 U.S. at 740. Notably, a presumption also exists that the amendment was made for reasons related to patentability. *Id.*

Third, Plaintiffs incorrectly claim to have rebutted the presumption that prosecution history estoppel applies. As noted earlier, a patentee may rebut the presumption by showing (1) the equivalent was "unforeseeable" at the time of the application, (2) the rationale underlying the amendment bears "no more than a tangential relation to the equivalent in question," or (3) "there [was] some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question." *Id.* at 740-41 (emph. added). Here, Plaintiffs assert only that the reason for the amendments are "tangentially related" to the alleged equivalent in question.[19] *Festo*, 535 U.S. at 741.

As a preliminary matter, Plaintiffs mischaracterize Siemens' argument (and the prosecution history) by looking solely at the patentee's amendment of (original) claim 1 of the parent application in response to the Examiner's rejection of (original) claim 2 of that application. [*See* Opposition, at 34.] As Siemens stated in its Opening Brief, however, prosecution history estoppel is mandated based on a series of rejections, including the First Rejection of all the claims (including original claim 2), as well as all subsequent rejections and amendments that resulted in the winnowing of the claims to independent claim 10 (which was later amended and re-numbered to become independent claim 1 of the '670 patent) and claims dependent thereon.

[19] Indeed, Siemens demonstrated – and Plaintiffs do not contest – that the equivalent asserted by Plaintiffs was foreseeable at the time of the amendment.

Looking at the entire relevant prosecution history, there is no question that the patentee's amendment adding the "same . . . code" limitation is directly (and not tangentially) related to the equivalent in question: "correlating codes." As noted earlier, based on the Examiner's rejection of the "directing and tracking" features as obvious, the applicant's stated reason for adding claim 10 was to "more specifically call for the method of tracking and directing specimens on the system." Similarly, Plaintiffs state that the reason that "correlated codes" are an alleged equivalent is because "with the two codes thus correlated, the laboratory automation system can keep track of the specimen container and carrier." [Opposition at 23 (emph. added).] Thus, by Plaintiffs' own admission, the alleged equivalent relates to tracking features, which is the same subject matter addressed in the stated reason given for adding claim 10 with its narrow "same . . . code" limitation. The stated reason for the amendment is thus directly related to the reason Plaintiffs argue that correlated codes are an equivalent.

Notably, the purpose of the "tangential relation" test is to establish whether the applicant could "reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent." *Festo*, 535 U.S. at 740-41 (emphasis added). Here, the applicant actually did draft original application claims that would have encompassed the alleged equivalent, but he abandoned all of them in favor of the narrow "same . . .code" limitation. Plaintiffs cannot now use DOE to recapture the territory that was earlier surrendered.[20] Partial summary judgment of no infringement under the doctrine of equivalents is thus proper.

3. The Dedication-Disclosure Rule Applies To Bar DOE Infringement

The dedication-disclosure rule also precludes application of the doctrine of equivalents. Where, as here, a patent applicant teaches subject matter in the specification, but does not recite the same subject matter in the claims, the unclaimed matter is dedicated to the public and the

[20] Notably, Plaintiffs do not dispute that if prosecution history estoppel applies, the applicant surrendered the territory between the broader limitation (which would have permitted marking the carrier with a different but correlated or associated code) and the more narrow same code limitation that ultimately issued. *Festo VIII*, 535 U.S. at 740; *see Deering Precision Instruments, L.L.C. v. Vector Distribution Sys., Inc.,* 347 F.3d 1314, 1325 (Fed. Cir. 2003).

applicant is barred from attempting to recapture it under the doctrine of equivalents. *Johnson & Johnston Associates Inc. v. R.E. Service Co.,* Inc. 285 F.3d 1046, 1054-55 (Fed. Cir. 2002) (affirming summary judgment of non-infringement under DOE under rule); *PSC Computer Prods., Inc. v. Foxconn Int'l, Inc.,* 355 F.3d 1353, 1360 (Fed. Cir. 2004) (rule foreclosed DOE infringement where specification disclosed using resilient materials, including plastic, but claims recited only metal parts and accused device used plastic parts); *Toro Co. v. White Consolidated Industries, Inc.*, 383 F.3d 1326, 1331-34 (Fed. Cir. 2004) (*en banc*) (affirming summary judgment of non-infringement under rule). The rule applies where, as here, "one of ordinary skill in the art can understand the unclaimed disclosed teaching upon reading the written description" within the patent. *PSC Computer*, 355 F.3d at 1360.

The dedication-disclosure rule is driven by the public notice function of patents, which is intended to permit the public "to discern both what has been disclosed and what has been claimed . . .[and] which products or processes would infringe the patent and which would not." *Id.* As the Federal Circuit has explained, if the patentee were allowed to reclaim the disclosed-but-unclaimed matter under the doctrine of equivalents, "the public would have no way of knowing which disclosed matter infringed and which did not." *Id.*

Here, the disclosure-dedication rule precludes Plaintiffs' DOE theory as a matter of law because the specification discloses correlating the codes on the carrier and container. And correlating codes is precisely the step that Plaintiffs allege is the equivalent of marking the carrier with the "same" code. The specification discloses correlating codes but the claims conspicuously do not recite correlation (nor the concept of correlating different codes). The correlation of codes teaching is dedicated to the public. Plaintiffs thus cannot recapture it through the doctrine of equivalents.

Plaintiffs' only attempt to defeat application of the rule fails. Plaintiffs argue that "the specification discloses the generic concept of 'correlation' of machine readable codes on the carrier and container and not specific, alternative examples of correlated codes, such as identical or different codes." [Opposition at 36.] Remarkably, Plaintiffs thus assert that the unclaimed subject matter – "correlating different codes" – was not identified to the public as an alternative to using the "same . . . code." Yet Plaintiffs' position is wholly inconsistent with their position on claim construction. In the claim construction context, Plaintiffs argue that one of ordinary skill in the art at the time of the invention would understand, based on the patent, that the "same . . .code" limitation means any codes that are correlated, whether the same or different. They even argue that the specification's "correlation of codes" disclosure is sufficient to notify the public that correlating different codes could infringe the claims. Plaintiffs cannot now take the opposite stance – that the same "correlation of codes" disclosure is insufficient to inform one of skill in the art that different codes can be correlated.[21]

Moreover, in his Declaration, the inventor opines that one of ordinary skill in the art would understand, based on the '670 patent, that correlating codes is required regardless of whether or not the codes were the same or identical:

> The '670 patent claims require a "database," as well as "inputting information" concerning the carrier and container codes into the database. **A look up table for associating the codes is a feature that could and would be implemented by a person of ordinary skill in the art. Associating the codes would be performed regardless of whether the codes are identical or not, in order to track the location of each specimen** . . . . [Markin Decl. ¶15 (emphasis added).]

He further concedes that the operation of the alleged invention "relies on correlating the code on the specimen and the code on the carrier, whether the codes are identical or different." [Markin Decl. ¶ 25.]

In short, the specification discloses precisely what Plaintiffs claim as the alleged equivalent: correlating codes. The policy behind disclosure-dedication rule applies with force because Siemens and the public have the right to practice the correlation of different codes that is

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21 Plaintiffs' reliance on *Pfizer, Inc. v. Teva Pharmaceuticals USA, Inc.*, 429 F.3d 1364, (Fed. Cir. 2005) in misplaced. In *Pfizer*, the patent disclosed generic saccharides, but the defendant "failed to point to parts of the '450 patent where the inventors identify [the alleged equivalent] as an unclaimed alternative. . . ." *Id.* at 1379. In contrast, here, the *Plaintiffs* identified and rely on the portion of the specification disclosing correlating codes. And unlike the patentee in *Pfizer*, Plaintiffs here concede that a person of ordinary skill in the art would conclude from the specification that different codes could be substituted for the same codes. [Opposition at 16-18; Markin Decl. ¶ 15.]

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taught in the specification, but that remains unclaimed in the patent claims.

E. There Is No Infringement Under The Doctrine Of Equivalents

The Court need not address any DOE infringement test because Plaintiffs' theory is precluded as a matter of law on the grounds addressed above. However, even if the Court reaches the DOE tests, there are no *genuine* disputes of *material* fact that preclude summary judgment under any of the three DOE tests Plaintiffs assert.

First, summary judgment is appropriate under the "function/way/result" test. Under that test, an accused device does not infringe a claim under DOE if, as to any claim element, it performs a similar function and achieves a similar result but does not operate in substantially the same way.[22] *See Wavetronix LLC v. EIS Electronic Integrated Systems,* 573 F.3d 1343, 1345 (Fed. Cir. 2009). Plaintiffs argue that using a different code on the puck and test tube is substantially similar to using the "same" code because the correlation of codes allows the accused and claimed systems to track specimens. But Plaintiffs erroneously restrict the marking steps to a single function (tracking the specimen), whereas the patent and prosecution history make clear additional functions of the limitations that the StreamLAB system does not perform in substantially the same way. And, Plaintiffs' own witness does not dispute the following material facts establishing that using different codes is a substantially different way of operating than the claimed method's use of the "same . . . code":

(1) The use of different codes allows the StreamLAB system to exploit the differences between two different types of codes to conform to the respective – and different – roles of test tubes and pucks, as described in the '670 patent. [Miller Decl. ¶13; *see* Exh. A, at 2:18-36 (carrier is used to transport single specimen); 3:13-34 (specimen identification code identifies specimen and tests designated by physician).] Nowhere in Dr. Markin's Declaration does he

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[22] Contrary to Plaintiffs' assertions, Siemens does not concede that the accused product has the same "function" and "result" as the asserted claim limitations. Rather, Siemens is moving for summary judgment only on the grounds that the accused product operates in a substantially different "way" because those facts are indisputable.

dispute this fact.[23]

(2) The use of different codes eliminates the need to code and/or re-code a puck every time it carries a new test tube and specimen, thereby streamlining the process and eliminating any need for manual or automatic re-coding of the puck. [Miller Decl. ¶14; *see* Exh. A, at 3:47-53 (each time a carrier arrives at receiving station it is given an identification code to correlate with the specimen).] On this point, Dr. Markin's assertion that his invention "does not prohibit re-correlation of the container and carrier codes if a specimen container were to be later transferred to a different carrier" is immaterial and misses the point. [*See* Markin Decl. ¶ 18.] The undisputed fact is that in the invention, if a container is removed from a carrier, to use that carrier again in the initial step of the claimed method, it has to be re-coded to carry a new container so that they share the "same code." [*See* Markin Decl. ¶ 26 (agreeing that the ability to re-use pucks without changing their codes is a "critical feature" of the "correlating codes" disclosure in the specification and the "very reason" why Markin does not believe the claims require "that the codes be identical to one another").] Continuously re-coding pucks and/or using a new puck each time a container is entered into the system is a substantially different way of operating than the StreamLAB system. [*Id.*]

(3) Using different codes allows the system to process multiple specimens efficiently and easily by permitting different pucks to carry different test tubes throughout the process. [Miller Decl. ¶ 15; *see* Exh. A at 1:1:35-2:15 (invention intended to overcome prior art problems of inefficiency and inability to process multiple specimens individually and automatically), 3:47-54 (same container and carrier of invention remain correlated to each other even "when container is

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23 Paragraph 19 of the Markin Declaration proves Siemens' point by recognizing that RFID and bar code systems are different in terms of "relative cost and reliability." [Markin ¶ 19.] Dr. Markin states: "Depending on the needs of a particular system, the implementation of bar code technology could be more or less expensive than implementation of RFID technology." Dr. Markin and Plaintiffs do not dispute that StreamLAB systems' use of two different types of codes allows it to exploit the benefits of both, which is fundamentally different than using just one code system as required by the claims.

removed from the carriage for specific testing at workstation").][24] On this point, Dr. Markin agrees with Mr. Miller's statement that "code independence" (i.e., that the puck code and test tube code are different from each other) "is critical to efficiently process multiple specimens and maximize throughput, allowing the system to re-use pucks without changing the RFI numbers regardless of the number of test tubes carried." [Markin Decl. ¶ 26.] Indeed, ignoring the claim requirement that the codes be the "same," Dr. Markin states that these "[t]hese features [identified by Miller relating to code independence] are the "**very reasons** that the specification of my patent describes specimen container and carrier codes that are 'correlated,' **rather than requiring that those codes be identical to one another** . . . ." [*Id.* (emphasis added)] Plaintiffs' own witness thus concedes that if Siemens' construction is adopted such that the codes must actually be the "same" as recited, the alleged equivalent – use of different codes – results in the accused system having "critical features" missing in the claimed method, including features related to the efficient specimen processing on the conveyor, increased throughput and reduction of human and/or machine error due to the fact re-used pucks do not need to be re-coded each time a new specimen is carried. [*Id.*; Miller Decl. ¶ 15].[25] The absence of such "critical

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24 Although the *claimed* invention may not technically preclude a container from separating from the original carrier and uniting with a different carrier during the process, it is undisputed that the original carrier would need re-coding to pick up a new specimen under the claimed method. This is wholly impractical and inefficient and thus not merely a "design choice" issue, and that is likely why the patent *specification* describes that "when the container is removed from the carriage," it remains correlated to the original carrier. [Exh. A, at 3:47-54.]

25 Dr. Markin's Declaration also fails to create any genuine issue of disputed fact because it fails to focus on the proper issue. The StreamLAB system operates in a way that is not substantially the same as the claimed method because it uses two different codes (regardless of the type used), whereas Dr. Markin's Declaration focuses on the irrelevant issue that the invention does not require any particular type of coding technology, such as barcodes, RFID codes or color codes. It is not the use of any specific type of code technology that renders StreamLAB substantially different, it is StreamLAB's use of two *different* code, and types of codes. [*See, e.g.*, Markin Decl. ¶¶ 14 ("precise technology used to mark" is not claimed); 21 (claims "do not state any particular marking technology"); ¶22 ("RFID chips, bar codes, color codes, etc. would all be equally functional on a carrier in this system"); ¶ 23 (invention does not require use of an RFID code); ¶ 24 (the use of any machine readable code (whether RFID chip, bar code, color code, etc.) on the pucks would result in the same overall system characteristics); ¶ 25 (specific RFID functionality is "not relevant to my invention"); ¶ 26 (code independence is not "unique to RFID").]

features" again demonstrates that the accused product operates does not operate in substantially the same way.

Accordingly, Summary judgment is appropriate under the function/way/result test. *See, e.g.*, *Wavetronix,* 573 F.3d at 1345; *Slimfold Manufacturing v. Kinkead Industries*, 932 F.2d 1453, 1457 (Fed. Cir. 1991); *Senior Industries, Inc. v. Thomas & Betts Corp.*, 2002 WL 31180745 at *4-5, 6 (N.D. Ill. 2002).

Second, summary judgment is proper under the "insubstantial differences" test. Under that test, "[a]n element in the accused device is equivalent to a claim limitation if the only differences between the two are insubstantial." *Honeywell*, 370 F.3d at 1139; *see Wavetronix,* 573 F.3d at 1345. Here, the differences between the claim limitation and the StreamLAB system's operation are substantial because using different codes (and even different *types* of codes) is substantially different than using the same code on both carrier and container. [Miller Decl. ¶¶ 6-8, 13-15.] Indeed, it is the *opposite* of using the same codes.

Plaintiffs try to avoid summary judgment by asserting that the substantial differences Siemens identifies are somehow not "important to the claimed invention" and merely relate to "physical differences" between the claimed invention and alleged equivalent. [Opposition at 24-25.] As set forth above, however, Siemens has demonstrated that the differences between using the same and different codes is fundamental to the operation of the system.

Finally, summary judgment is appropriate under the "interchangeability" test. That test looks to whether a skilled artisan would contemplate the interchange as a design choice (e.g., computer software versus computer hardware). *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1383 (Fed. Cir. 2002). Here, using the same code and different codes is not a simple design choice – it is a fundamentally different approach. Contrary to Plaintiffs' Opposition, even if there might be some occasion to interchange the use of an RFID code and barcode, Plaintiffs' theory would require completely interchanging the "same" codes for "different" codes throughout the operation of the system. As set forth in the Miller Declaration and Siemens' Opening Brief, such an interchange would fundamentally alter the functionality of the system. [*See generally* Miller Decl. ¶¶ 10-16.][26] In short, a skilled artisan would not consider the differences to be mere design choices – Dr. Markin concedes they relate to "critical features" of the system – and infringement under this test fails as well. [*See, e.g.*, Markin Decl. ¶ 26.]

In sum, Plaintiffs cannot establish infringement under any test using the doctrine of equivalents. Accordingly, summary judgment of non-infringement is appropriate.

IV CONCLUSION

Plaintiffs' Opposition fails to raise any factual or legal issue to prevent entry of partial summary judgment of non-infringement. As a matter of basic patent law and common sense, the '670 patent's requirement for marking a carrier with the same machine readable code does not encompass Siemens' product that uses different codes, and thus there is no literal infringement. Nor can Plaintiffs avoid that limitation by alleging infringement under the doctrine of equivalents, as they are precluded from doing so as a matter of law based on the "all elements rule," the doctrine of prosecution history estoppel, and the dedication-disclosure rule. And even if Plaintiffs could assert equivalents, there can be no infringement as a matter of law under such a theory, as there is no genuine dispute that there are substantial differences between Siemens' products and the asserted claim limitations. Accordingly, there is no infringement as a matter of law, and summary judgment is therefore proper.

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26 Plaintiffs' reliance on Siemens' witness, Kerry Miller's patent, to prove DOE infringement under the interchangeability test is misplaced. Not only is the Miller patent unrelated to the '670 patent, but the statement on which Plaintiffs rely merely concerned whether bar codes or RFID tags could both be used in tracking operations, which is not the issue in this case: namely, whether the same code, and type of coding (whether bar code or RFID), must be used on both a carrier and container. Moreover, the Miller patent is hardly material to this issue because it issued in 2010, nearly seven years after the parent application and years after the StreamLAB system was developed.

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CERTIFICATE OF SERVICE

This certifies the undersigned attorney filed this document with the Court using the CM/ECF system, which caused service to be made on the following attorneys on this 16th day of July, 2010.

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